

RD28684-2

REMARKS

Claims 1-50 are pending in the present Application. Claim 1 has been amended, claim 2 has been canceled, claims 32-50 have been withdrawn, and claim 51 has been added, leaving claims 1, 3-31, and 51 for consideration upon entry of the present Amendment. Claim 1 has been amended to include particular polymers as taught in the specification as filed at paragraph [0043]. No new matter has been introduced by these amendments. Please cancel claim 2 without prejudice to the subject matter disclosed therein. Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Provisional Double Patenting Rejection

Claims 1-31 stand rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-47 of copending Application No. 10/648,542. Filed concurrently with this amendment is a terminal disclaimer under 37 CFR 1.321(c). In view of the terminal disclaimer, the Applicants respectfully request removal of the double patenting rejection.

Claim Rejections Under 35 U.S.C. §§ 102(b) and (e)

Claims 1-3, 6-7, 17, 20, and 24-26 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by US 2002/0062054 to Cistone et al. ("Cistone"). Claims 1-25, 27, and 30 stand rejected under 35 U.S.C. § 102(e), as allegedly anticipated by US 2003/0236384 to Silvi et al. ("Silvi").

Cistone generally discloses a process and apparatus for reclamation of waste polystyrene-type materials. The process and apparatus include devolatilization of dissolved polystyrene and recovery of the polystyrene-type material in a solid form.

Silvi generally discloses an extrusion method to preparing polycarbonates from a solution of an oligomeric polycarbonate. In one embodiment, the oligomeric polycarbonate

RD28684-2

can be pre-heated and subsequently fed to a devolatilizing extruder equipped for rapid flashing off the solvent.

To anticipate a claim, a reference must disclose each and every element of the claim. *Lewmar Marine v. Varient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987).

In view of the amendment to claim 1, the Applicants respectfully contend that neither Cistone nor Silvi teach each and every element of the claim. Specifically, neither reference teaches the particular polymers as provided in amended claim 1. Claims 3-27 and 30 all ultimately depend from claim 1. Therefore, the Applicants respectfully request reconsideration and removal of the § 102(b) and (e) rejections.

Claim Rejections Under 35 U.S.C. § 103(a)

Claim 18 stands rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Cistone in view of Bash, "Analyzing Devolatilization Extruders for Residuals Optimization" ("Bash").

Bash generally discloses an analysis of a four vent devolatilizing extruder in terms of operating conditions and screw design.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness, i.e., that all elements of the invention are disclosed in the prior art. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

As mentioned previously, Cistone fails to teach each and every element of amended claim 1, including the particular polymers provided therein. Furthermore, Bash does not provide the missing teaching for these particular polymers. Therefore, a *prima facie* case of obviousness has not been established. As Cistone and Bash, alone or in combination, fail to teach or suggest each and every element of amended claim 1, the Applicants respectfully request reconsideration and removal of the obviousness rejection of claim 18.

RD28684-2

New Claim 51

Claim 51 finds support in the specification as filed at paragraph [0043].

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 07-0862

Respectfully submitted,

CANTOR COLBURN LLP

By 

Roberta L. Pelletier

Registration No. 46,372

Date: November 10, 2004
CANTOR COLBURN LLP
55 Griffin Road South
Bloomfield, CT 06002
Telephone (860) 286-2929
Facsimile (860) 286-0115
Customer No.: 23413